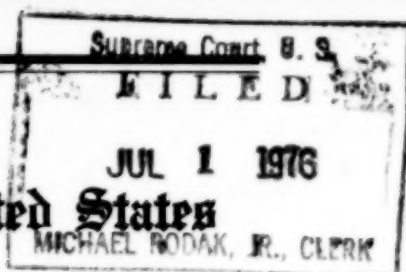


IN THE
Supreme Court of the United States
October Term, 1975



No. 75-1743

FRANK PETER DOYLE, JOHN HERBERT CHARLES NAYLER
and GEORGE NEWBOLD ROLINSON,
Petitioners,

v.

JOHN C. SHEEHAN,
Respondent.

**RESPONDENT'S BRIEF IN OPPOSITION TO
PETITION FOR WRIT OF CERTIORARI TO
THE UNITED STATES COURT OF APPEALS
FOR THE FIRST CIRCUIT**

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Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT

Opinions Below

The opinions below appear at pages 1a through 5a of the Appendix to the Petition and at pages 1 through 3 of the Supplemental Appendix to the Petition.

Jurisdiction

The statutory provisions are adequately set forth in the Petition.

Statement of the Case

Petitioner's Statement of the Case has omitted several important facts and judicial decisions relevant to the Court's consideration of the Petition.

Following completion of the Doyle et al. discovery from Sheehan referred to in the paragraph bridging pages 6-7 of the Petition, Sheehan requested production of documents under authority of 35 U.S.C. §24 from Doyle, Rolinson and Nayler, the alleged coinventors. The District Court for the District of Massachusetts ordered Doyle et al. to produce the documents and an appeal was taken. On March 31, 1975 the First Circuit Court of Appeals reversed the District Court (*Sheehan v. Doyle*, 513 F.2d 895) in a case of first impression sustaining Doyle et al. on the ground that 35 U.S.C. §24 "does not confer jurisdiction upon the district court, acting on its own, to grant Rule 34 discovery directly, whether against a non-resident alien or a resident citizen" (513 F.2d at 898). We petitioned this Court on behalf of Sheehan but the Writ of Certiorari was denied. (— U.S. —, October 6, 1975, No. 74-1644).

The decision below is therefore the second instance in which the First Circuit Court reviewed 35 U.S.C. §24, and merely confirmed the construction and application of its prior precedent. The parties have thus come full circle in less than a year, with Doyle et al. now urging a review of the circuit court's construction of 35 U.S.C. §24, which review the Court has previously denied to Sheehan.

Summary of the Argument

Respondent believes that the decision of the court below does not present an issue for review by this Court for the following reasons:

- (a) Pending legislation to revise the patent laws generally would eliminate this challenged provision of 35 U.S.C. §24 altogether, and if enacted prior to the Court's final decision, could render the Court's decision moot.
- (b) Arguments relating to the merits of the discovery issue were referred to by the court below and the ultimate effect of its decision is manifestly correct.
- (c) The present case does not involve an important question of law which would substantially affect the rights of the public.

Reasons for Denying the Writ

I—Pending legislation to revise the patent laws generally would eliminate this challenged provision of 35 U.S.C. §24 altogether and if enacted prior to the Court's final decision, could render the Court's decision moot.

While we cannot deny the conflict in the decisions of the Courts of the First and Third Circuits with those of the courts of the remaining circuits which have construed and applied 35 U.S.C. §24, we do not believe that this matter warrants the Court's attention at this time.

Petitioners have twice quoted from that part of the opinion by the court below which stated that this conflict of

statutory construction could be resolved by this Court. However, the court below also recognized that the conflict could be resolved by another body, i.e., the Legislature, and the complete passage (of which Petitioners have quoted only a part) is as follows:

We regret the uncertainty which a circuit split creates. There are, however, possible remedies. The Supreme Court may think it desirable to terminate the divergent interpretations that now exist. Alternatively, other circuits may follow the third circuit in abandoning the earlier construction. And the Commissioner of Patents, exercising such powers as he now has, may find that he is able to contribute to clarification of the situation. *Finally, of course, Congress may by legislative enactment make clear its wishes in this unsettled area.* (Appendix to Petition, pages 3a-4a) [emphasis supplied]

The Congress, in fact, does presently have under consideration legislation which, if enacted, would significantly revise the specific statutory section in question. This legislation, entitled "*An Act For the general revision of the Patent Laws, title 35 of the United States Code, and for other purposes,*" has already been passed by the full Senate as S.2255. On March 1, 1976 this act was referred to the Committee on the Judiciary of the House of Representatives. An abridgment of this pending legislation reproducing the relevant sections is included as Appendix A to this brief.

In the Senate-passed version of S.2255, Sections 23 and 24 put control of patent interference discovery matters solely in the hands of the Board of Patent Interferences with the power to issue subpoenas. See Sections 5(c)(3)

and 136 of S.2255. Rules for obtaining discovery are to be established by the Commissioner of Patents and Trademarks. Nowhere in S.2255 is there a provision comparable in terms or effect to the provisions of the present 35 U.S.C. §24. Thus, the federal courts will not have primary jurisdiction to issue subpoenas in connection with discovery in patent interference proceedings. The courts will have authority to review the issuance of, and compliance with subpoenas issued by the Patent Office Board.

While no public hearings have been held, it is possible that should the Court grant the Petition the legislation could be enacted prior to the Court's final opinion on the proper construction of the present 35 U.S.C. §24. The question would thereby be rendered moot since further discovery proceedings would have to be undertaken in accordance with the provisions of the new statute.

In view of these recent developments and the significant changes in the pending legislation governing the conduct of discovery in patent interference proceedings we do not believe that the issue raised by Petitioners warrants the Court's attention at this time. We respectfully submit that it would be within the exercise of the sound discretion of the Court to deny the Petition in view of this pending federal legislation, which in the version already passed by the Senate would render moot the narrow issue of law under consideration.

II—The effect of the ruling of the court below is manifestly correct and warrants a denial of certiorari.

It is an established principle governing appellate review that a ruling or decision of a lower court itself correct in law, will not be disturbed on appeal merely because given for a wrong reason.

Regardless of the basis of the district court's original decision, the result—to deny discovery to Doyle et al.—was correct under the controlling precedent.

Petitioners have admitted in their brief that their sole basis for the discovery is to challenge the accuracy of the inventorship entity named in the patent which is in interference. Those tribunals having primary jurisdiction over the conduct of the interference proceedings have held that the issue of inventorship cannot be determined under the circumstances of this interference.*

The opinion of the court below reproduced in Appendix A to the Petition noted that Sheehan had argued that the issue of inventorship was entirely irrelevant in the context of the interference (Petition, page 2a). The court below, while obviously never reaching the merits of the issues of scope and relevance, did have in the record before it a final decision by the Commissioner of Patents holding

* See, for example, *Cooper v. Hubbell*, 53 F.2d 1072 (CCPA 1931); *Derby v. Whitworth*, 62 F.2d 368 (CCPA 1932); *Hess v. Dryfuss*, 104 F.2d 801 (CCPA 1939); *Smith v. Kliersath*, 120 F.2d 1015 (CCPA 1941); *Sherman v. Hope, Jr.*, 161 F.2d 263 (CCPA 1947); *Mortsell v. Laurila*, 301 F.2d 947 (CCPA 1962); *Huang v. Cheney*, 362 F.2d 816 (CCPA 1966); *Beeber et al. v. Krough et al.*, 403 F.2d 743 (CCPA 1968); and *Arey et al. v. Streed and Yan*, 176 USPQ 274 [no Fed. cite] (P.O. Bd. of Pat. Inter. 1971).

that the issue of third party inventorship of the Sheehan patent could not be raised by Doyle et al. in this particular interference. This decision on the Doyle et al. petition to the Commissioner of Patents dated April 14, 1975 is reproduced as Appendix B hereto.

We believe that inasmuch as the effect of this ruling by the Commissioner conclusively estops Doyle et al. on the merits from ever obtaining the discovery sought, the correctness of the result of the decision by the court below is established.

Since the order denying discovery was supported by a sound, although unstated, theory of law, this Court should not consider overturning the decision merely because the stated reasoning has been challenged. Under these circumstances, and in accordance with the prior decisions of this Court, the petition should be denied.

III—The present case does not involve an important question of law which would substantially affect the public interest.

Approximately one year ago we filed on behalf of Sheehan a petition for a writ of certiorari to the First Circuit Court of Appeals raising substantially the same question with regard to that court's construction of 35 U.S.C. §24. At that time there were pending two other petitions for writs of certiorari to the Third Circuit Court of Appeals in the cases of *Frilette et al. v. Kimberlin et al.*, 508 F.2d 205 (1974), and *Duffy v. Barnes et al.*, 508 F.2d 205 (1974), likewise challenging that court's construction of 35 U.S.C. §24. This Court denied all three petitions in

1975 (421 U.S. 979). Since the conflict between the decisions of the circuits was as apparent then as it is now, and yet each of the petitions was denied, we can only conclude that other matters had taken precedence over this narrow question relating to patent interference practice.

Putting the matter in perspective, it is apparent that the effect of denying discovery to Petitioners does not decide any of the interference issues on the merits, but involves only a matter of discovery procedures. Most significant is that the sole effect of the decision which Petitioners ask this Court to review is to deny to them the federal district court as an alternate forum of *first resort* for judicial subpoenas to be used in aid of discovery related to the patent interference proceeding. The ruling, while adverse to Petitioners, is not necessarily finally determinative of their right to the discovery sought. The existing Rules of Practice of the Patent and Trademark Office provide that such discovery may be granted upon application if supported by a proper showing. Rule 287(c) [37 C.F.R. Section 1.287(c)] reproduced in Appendix C to this Brief outlines the procedure and requirements. Petitioners have not brought a motion for the discovery sought under Patent Office Rule 287(c), and have therefore not exhausted their administrative remedies. We believe that it was the specific purpose of the First Circuit Court to impose upon interference parties the requirement that they first apply to, and obtain authorization from, the Patent Office Board of Interferences for any such additional discovery. For these reasons, the decision of the court below does not present an issue for review by this Court.

Conclusion

For the reasons stated the Petition should be denied.

Respectfully submitted,

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APPENDICES

APPENDIX A

94th Congress, 2d Session S. 2255—

An Act for the general revision of the Patent Laws, title 35 of the United States Code, and for other purposes. (Sections 5(c)(3), 23, 24 and 136 only.)

94TH CONGRESS
2D SESSION

S. 2255

IN THE HOUSE OF REPRESENTATIVES

MARCH 1, 1976

Referred to the Committee on the Judiciary

AN ACT

For the general revision of the Patent Laws, title 35 of the United States Code, and for other purposes.

1 *Be it enacted by the Senate and House of Representatives of the*
2 *United States of America in Congress assembled, That, in accordance*
3 *with the authority granted by article 1, section 8, clause 8 of the*
4 *United States Constitution, title 35 of the United States Code entitled*
5 *"Patents", is hereby amended in its entirety to read as follows:*

"TITLE 35—PATENTS

"PART	Sec.
"I. PATENT AND TRADEMARK OFFICE.....	1
"II. PATENTABILITY OF INVENTIONS AND GRANT OF PATENTS.....	100
"III. PATENTS AND INFRINGEMENT OF PATENTS.....	261
"IV. PATENT COOPERATION TREATY.....	351

"PART I—PATENT AND TRADEMARK OFFICE

"CHAPTER	Sec.
"1. ESTABLISHMENT, OFFICERS, FUNCTIONS.....	1
"2. PROCEEDINGS IN THE OFFICE.....	21
"3. PRACTICE BEFORE THE OFFICE.....	81
"4. OFFICE FEES.....	41

"Chapter 1.—ESTABLISHMENT, OFFICERS, FUNCTIONS

"Sec.
"1. Establishment.
"2. Seal.
"3. Commissioner and other officers.
"4. Restrictions on officers and employees as to interest in patents.
"5. Board of Examiners-in-Chief.
"6. Library.
"7. Classification of patents.
"8. Certified copies of records.
"9. Publications.
"10. Research and studies.
"11. Annual report.

1 **"§ 5. Board of Examiners-in-Chief**

2 **"(a) There shall be in the Office not to exceed sixty examiners-in-**
3 **chief, who shall be appointed under the competitive service.**

4 **"(b) The examiners-in-chief shall constitute a Board of Examin-**
5 **ers-in-Chief. The examiners-in-chief shall be persons of competent**
6 **legal knowledge and scientific ability. The Chairman of the Board**
7 **shall be appointed by the Commissioner.**

8 **"(c) The Board of Examiners-in-Chief shall:**

9 **"(1) review (as provided in chapter 12 of this title) final rejec-**
10 **tions by primary examiners; and**

11 **"(2) render other decisions and orders, and take other agency**
12 **action, as provided in this title; and**

13 **"(3) perform the functions specified as being performed by a**
14 **Board of Patent Interferences in other Acts of Congress and**
15 **when performing said function shall constitute a Board of Patent**
16 **Interferences; and**

17 **"(4) render other decisions and orders as the Commissioner**
18 **may by regulation or order prescribe.**

19 **"(d) Except as otherwise provided in or pursuant to this title, the**
20 **Board of Examiners-in-Chief shall exercise all judicial functions of**
21 **the Office, including all agency review of appeals, under this title.**
22 **Except as provided otherwise in this title, the decision of the Board**
23 **of Examiners-in-Chief shall constitute final agency action (as that**
24 **term is defined in 5 U.S.C. 551) in all matters considered by it, and**
25 **shall be the final decision of the Office for the purposes of chap-**
26 **ter 13 of this title.**

27 **"(e) Each appeal or other action shall be heard or considered by a**
28 **panel of one or more members of the Board of Examiners-in-Chief,**
29 **as the Commissioner by general regulation shall prescribe. Said panel**
30 **shall be designated for each case by the Chairman of the Board. The**
31 **Board of Examiners-in-Chief shall have sole power to grant rehear-**
32 **ings.**

A2.

9

23

"Chapter 2.—PROCEEDINGS IN THE OFFICE

"Sec.

- "21. Day for taking action falling on Saturday, Sunday, or holiday.**
- "22. Form of papers filed.**
- "23. Issue of subpoenas and other orders by Board of Examiners-in-Chief; review and enforcement.**
- "24. Issue of subpoenas and other orders in investigations; review and enforcement.**
- "25. Oath and declaration in lieu of oath.**
- "26. Effect of defective or missing execution.**
- "27. Postal interruptions.**

1 **"§ 23. Issue of subpoenas and other orders by Board of Examiners-**
2 **in-Chief; review and enforcement**

3 "(a) Any party to a proceeding before the Board of Examiners-in-
4 Chief may apply at any time to the Board or any member thereof for
5 subpoenas or discovery orders to provide testimony, evidence, deposi-
6 tions, or other information, and the Board or any member thereof shall
7 issue the same ex parte to (1) the Solicitor; (2) parties to proceedings
8 had pursuant to section 5(c) (3) or 136 of this title; and (3) upon a
9 showing of good cause, to parties to proceedings had pursuant to sec-
10 tion 135 of this title. Any member also may issue such subpoenas or
11 orders on his own motion in any proceeding. Subpoenas and orders may
12 issue against the applicant or any person within the jurisdiction of the
13 United States, whether or not he is a party in the proceeding.

14 "(b) (1) The Commissioner shall establish rules for obtaining such
15 discovery, testimony, evidence, affidavits, or other information. Subject
16 to subsection (a) of this section, such rules shall provide any party to
17 the proceedings all discovery permitted, and the sanctions, other than
18 contempt, for noncompliance therewith, prescribed in the Federal
19 courts pursuant to the Federal Rules of Civil Procedure, as now in
20 force or amended hereafter, with such different time limits as the
21 Commissioner may by regulation prescribe. Such rules shall provide,
22 further, for protective orders and for the payment of witness fees
23 and expenses as prescribed in the Federal Rules of Civil Procedure
24 for proceedings in the district courts.

25 "(2) (A) The Board of Examiners-in-Chief or any member thereof
26 shall have the power, in accordance with such regulations not incon-
27 sistent with the Federal Rules of Civil Procedure as the Commis-
28 sioner shall prescribe, to sustain, quash, or modify subpoenas or orders
29 issued pursuant to subsection (a) of this section.

30 "(B) In the case of a person (other than an employee or agent of
31 a party to the proceeding) not party to the proceedings before the
32 Board of Examiners-in-Chief, such person also may move to quash
33 or modify subpoenas or orders issued pursuant to subsection (a) of
34 this section in the United States District Court for the judicial district
35 in which such person resides.

36 "(c) (1) Agency action pursuant to subsections (a) and (b) of this
37 section shall not be deemed final decisions or orders for the purposes of
38 chapter 13 of this title. Judicial review of orders pursuant to subsec-
39 tions (a) and (b) of this section may be had upon review of the final
40 decision or order in the entire proceeding, pursuant to chapter 13 of

1 this title, or as may otherwise be required by sections 701-706 of title
2 5, United States Code.

3 “(2) (A) Any party aggrieved by refusal or failure to comply
4 with a subpoena or order issued, and not quashed, pursuant to sub-
5 section (a) or (b) of this section, may apply for such civil enforce-
6 ment by moving for an order to show cause why the person refusing
7 or failing to comply with such subpoena or order should not be com-
8 manded by the court to comply therewith. Such application shall be
9 to the United States District Court for the District of Columbia. The
10 process of such district court for such purpose shall run through the
11 United States and otherwise as provided by the Federal Rules of
12 Civil Procedure or any Federal statute.

13 “(B) In the case of a person (other than an employee or agent of a
14 party to the proceeding) not a party to the proceeding before the
15 Board of Examiners-in-Chief, the United States District Court for
16 the District of Columbia may, if it finds that the interests of justice,
17 judicial economy, and fairness to such person permit, transfer such
18 application to the United States district court for the judicial district
19 in which such person resides or may be found.

20 “(3) Disobedience of any court order entered pursuant to this sub-
21 section shall be punishable as a contempt.

22 **“§ 24. Issue of subpoenas and other orders in investigations; review**
23 **and enforcement**

24 “(a) To carry out the provisions of this title with respect to fraud
25 and inequitable conduct, the Board of Examiners-in-Chief or any
26 member thereof shall, upon the application of the Solicitor, and upon
27 a showing of good cause, issue a subpoena or order to any applicant,
28 patentee, or person within the jurisdiction of the United States—

29 “(1) requiring him to appear before a designated representative
30 of the Office in a nonadjunctive proceeding to testify, or to
31 produce documentary evidence or other information or material;
32 or

33 “(2) requiring him to file reports or answers in writing to
34 specific questions—

35 relating to any investigation or inquiry by the Solicitor, involving
36 conduct which may be a violation of sections 31, 32, 33, 115, 131, 135
37 or chapter 19 of this title, or likely to lead to the production of infor-
38 mation relating thereto, whether or not the subject matter of the
39 investigation or inquiry may also be involved in any proceeding

1 before a primary examiner or the Board of Examiners-in-Chief, or
2 in any other proceeding before a court or other tribunal. A person
3 so required to appear shall be entitled to the payment of witness fees
4 and expenses as prescribed for proceedings in the district courts. A
5 subpoena or order requiring such a person to appear at a proceeding
6 held pursuant to paragraph (1) of this subsection may issue against
7 any such person within the jurisdiction of the United States.

8 “(b) Agency review of subpoenas or orders issued pursuant to this
9 section shall be in accordance with such rules as the Commissioner may
10 prescribe.

11 “(c) In the case of disobedience to or failure to comply with such
12 subpoenas or orders, the Solicitor may, in his discretion, seek enforce-
13 ment thereof by the procedure specified in section 23(c) of this chapter,
14 and the procedures specified therein shall be applicable to subpoenas
15 and orders entered pursuant to this section.

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8

"Chapter 12—EXAMINATION OF APPLICATION

"Sec.

"131. Examination of application.

"132. Examination proceedings.

"133. Time for prosecuting application.

"134. Appeal to the Board of Examiners-in-Chief.

"135. Opposition proceeding on the basis of information cited or furnished by others.

"135A. Reexamination.

"136. Procedures in priority of invention proceeding.

"137. Burden of persuasion.

"138. Effect of proceedings before the Office.

"139. Settlement agreements.

1 **"§ 136. Procedures in priority of invention proceeding**

2 **"(a) (1) Whenever there are two or more pending otherwise allow-**
3 **able applications naming different inventors and claiming the same**
4 **or substantially the same subject matter, and a priority of invention**
5 **proceeding is instituted in accordance with subsection (b) of this sec-**
6 **tion the Office shall designate as the 'senior party'—**

7 **"(A) the inventor named in the application having the earlier**
8 **or earliest actual filing date in the United States, with respect**
9 **to such subject matter, or**

10 **"(B) if two or more pending applications have the same actual**
11 **filing date in the United States, the inventor named in one such**
12 **application, in accordance with such regulations as the Commis-**
13 **sioner shall prescribe.**

14 **"(2) The Office shall designate each inventor other than the senior**
15 **party as a 'junior party.'**

16 **"(b) The priority of invention between or among the senior party**
17 **and each junior party shall be decided by the Board of Examiners-**
18 **in-Chief in a priority of invention proceeding, in accordance with**
19 **such regulations as the Commissioner shall establish, if—**

20 **"(1) the application of such junior party is otherwise allow-**
21 **able;**

22 **"(2) such junior party makes a prima facie showing of prior**
23 **invention; and**

24 **"(3) such junior party offers to present evidence in support of**
25 **such showing, within such time as the Commissioner shall pre-**
26 **scribe by regulations.**

27 **"(c) (1) Subject to paragraph (2) of this subsection, and para-**
28 **graphs (2) and (3) of subsection (b), whenever an otherwise allow-**
29 **able claim of an application is for the same or substantially the same**
30 **subject matter as a claim of an issued patent, the Office shall initiate a**
31 **proceeding to determine priority of invention.**

32 **"(2) No claim for the same or substantially the same subject matter**
33 **as a claim of an issued patent shall be allowed unless such claim is**
34 **made within one year after the date on which such issued patent was**
35 **granted. Nothing contained in this paragraph shall, however, preclude**
36 **any person from asserting the unpatentability to the patentee of the**
37 **subject matter of such a claim.**

38 **"(d) Failure of a junior party applicant to proceed under subsec-**
39 **tion (b) or (c) of this section shall preclude such applicant from**
40 **asserting priority of invention with respect to the subject matter**

1 claimed in the application, for the purpose of obtaining a patent.
2 Failure of a junior party patentee to proceed under subsection (c) of
3 this section shall operate to cancel such claim from the patent, and
4 notice thereof shall be endorsed on copies of the specification of the
5 patent thereafter distributed by the Office.

6 “(e) If any claim of an application involved in a priority of inven-
7 tion proceeding is allowable with respect to subject matter not within
8 the scope of the priority of invention proceeding, the Commissioner
9 may, pursuant to section 155 of this title, issue a patent on such
10 otherwise allowable claim or claims.

11 “(f) In any proceeding under this section, the Board of Examiners-
12 in-Chief, or any party, may raise the question of the patentability of
13 any claim which is involved in the proceeding or of any claim of the
14 patent or application of one party over the subject matter claimed or
15 disclosed in the patent or application of the other party, and such
16 question shall be considered in the proceeding.

17 “(g) Upon a final decision in a priority of invention proceeding
18 from which no appeal or other review has been or can be taken or had,
19 the prevailing party shall be deemed entitled to priority of invention
20 with respect to the subject matter of the claim or claims involved in the
21 proceeding and with respect to the parties to the proceeding. The
22 corresponding claims of the application or patent of each other party
23 shall be rejected or canceled. Thereafter, pursuant to such regulations
24 as the Commissioner may prescribe, the primary examiner or exam-
25 iners shall continue the examination of the application or applications,
26 pursuant to section 132 of this title.

27 “(h) Unless the prevailing party has elected interim issuance of a
28 patent pursuant to subsection (e) of this section, the term of his patent,
29 pursuant to section 154(b) of this title, shall be extended by a period
30 equal to the time elapsed between the date he was made a party to the
31 proceeding under this section and the date a final decision in his favor
32 became effective. If he elected such interim issuance, the normal term
33 pursuant to section 154(b) shall apply.

B1

APPENDIX B

**Decision by the Commissioner of Patents, dated April
14, 1975 in Interference No. 97,577, On Petition**

U.S. DEPARTMENT OF COMMERCE

PATENT OFFICE

(Emblem)

Address Only: COMMISSIONER OF PATENTS
WASHINGTON, D.C. 20231

Interference No. 97,577 :

SHEEHAN : On Petition

v. :

DOYLE *et al.* :

April 14, 1975

This is a petition by Doyle et al. from a decision on petition, November 18, 1974 in which the Commissioner acknowledged the right of Doyle et al. to call any witnesses of whom Sheehan had notice under Rule 287(a) or the equivalent thereof but limited to the question as to the sufficiency or inoperativeness of the disclosure of the parent Sheehan application S.N. 643,260, filed March 1, 1957. The Commissioner went on to state:

No basis or precedent is found for permitting, on the present record, testimony as to any other contention with respect to Sheehan's being accorded benefit of that application.

Doyle et al. assert that while they appreciate the favorable aspects of the Commissioner's decision, it is believed

important and equitable that they be permitted to present all testimony which would bear on Sheehan's right to be accorded the benefit of his abandoned parent application of March 1, 1957. The petition is opposed by Sheehan.

Doyle et al. allege that as a result of discovery proceedings including the deposition of Sheehan, they believe that they should be permitted to present factual testimony directly dealing with Sheehan's lack of "right" to the filing date of Sheehan's parent application. It is noted that Doyle et al. have not established in the petition that as a result of the discovery proceedings, the "factual testimony" to be presented even concerns matter ancillary to priority. As properly pointed out by Sheehan, Doyle et al. have demonstrated no new or additional bases for the relief sought. Accordingly, the Doyle et al. petition is *denied*.

Nor should this denial be interpreted as an invitation to Doyle et al. to make an additional showing relative to matters ancillary to priority. This interference, declared in February 1971 has been sufficiently protracted by a proliferation of papers filed by both parties herein and the time has come for the interference to move forward.

On February 3, 1975 Doyle et al. filed a supplement to the petition treated above. In this supplement, Doyle et al. desires to supplement same with copies of certain pages of a deposition of Sheehan and with certain laboratory notebooks of one Dr. Kenneth Henery-Logan. According to Doyle et al. these documents establish a prima facie inconsistency in the record as to the inventorship of the involved Sheehan patent; therefore Doyle et al. conclude that when testimony is taken to establish that the involved Sheehan patent does not have the correct inventorship entity, then

a prima facie case will have been raised that the patent is not entitled to the benefit of the parent Sheehan application. Additionally, Doyle et al. contend that a prima facie case would exist that said parent application does not contain the correct inventorship entity and this additionally would preclude reliance by Sheehan on the March 1, 1957 date for priority purposes in the instant interference. Sheehan has replied to the supplement to the petition and subsequent thereto pertinent papers were filed by both Sheehan and Doyle et al.

It is noted, under the circumstances of this case, there appears to be no issue of originality between the parties. Therefore, the issue of whether the involved Sheehan patent has the correct inventorship entity is an issue directed to third party inventorship which is not ancillary to priority and therefore may not be raised in an interference proceeding. *Mortsell v. Laurila*, 133 USPQ 380 (CCPA 1962); *Huang v. Cheney*, 150 USPQ 295 (CCPA 1966); *Beeber v. Grogh*, 159 USPQ 594 (CCPA 1968).

Accordingly, the Doyle et al. petition, supplemented by the paper filed February 3, 1975 is *denied*.

C. MARSHALL DANN

Commissioner of Patents and Trademarks

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code of federal regulations

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**Patents, Trademarks,
and Copyrights**

Revised as of July 1, 1973



Chapter I—Patent Office

37 C.F.R. 1.287

§ 1.287 Discovery.

(a) (1) Each party who expects to take testimony must serve on each opposing party who requests service the following:

(i) A copy of each document in his possession, custody, or control and upon which he intends to rely,

(ii) A list of and a proffer of reasonable access to things in his possession, custody, or control and upon which he intends to rely, and

(iii) A list giving the names and addresses of all persons whom he intends to call as witnesses and indicating the relationship of each person to the invention in issue.

(2) Dates for compliance with subparagraph (1) of this paragraph will be set in accordance with the following:

(i) The date by which all parties may request service shall be not less than 10 days from the date of the order setting testimony times;

(ii) The date for service by all junior parties shall be not less than 30 days from the date of the order setting such times;

(iii) The date for service by the senior party shall be not less than 10 days from the date set for the close of testimony in chief of all junior parties.

(3) Where more than two parties are involved and one of the junior parties is not entitled to take testimony as to a more senior party, the requirements of subparagraphs (1) and (2) of this paragraph shall not be applicable as between such parties.

(b) The provisions of paragraph (a) of this section are without prejudice to the right of a party, where appropriate, to obtain production of documents or things during cross-examination of an opponent's witness or during his own period for rebuttal testimony.

(c) Upon motion (§ 1.243) brought by a party during the period for preparation for testimony, or thereafter as authorized under § 1.245, and upon a showing that the interest of justice so requires, the Board of Patent Interferences may order additional discovery as to matters under the control of a party within the scope of the discovery rules of the Federal Rules of Civil Procedure, specifying the terms

and conditions of such additional discovery. An order by the Board granting or denying a motion under this paragraph shall not be subject to review prior to a decision awarding priority.

(d) (1) A party will not be permitted to rely on any document or thing in his possession, custody, or control, or on any witness, not listed and served by that party as required by paragraph (a) of this section, except upon a promptly filed motion accompanied by the proposed additional documents or lists together with a showing of sufficient cause as to why they were not served by the date set pursuant to paragraph (a) of this section.

(2) Any failure to comply with an order under the provisions of paragraph (c) of this section may be considered by the Board of Patent Interferences as basis for applying appropriate restrictions against the party failing to comply, for holding certain facts to have been established, and in an appropriate case for awarding priority against him, or for taking such other action as may be deemed appropriate.

(e) The parties may by agreement among themselves modify any of the foregoing requirements consistent with the schedule of times for taking testimony and filing the record. In the absence of such agreement, discovery will not be permitted prior to the period set for the preparation for testimony.

[36 F.R. 8733, May 12, 1971]